

## REMARKS/ARGUMENTS

Claims 1-10 are pending.

Claim 1 is amended to incorporate the striking faces recited in claim 9. Accordingly, claim 9 is canceled.

Claim 1 is also amended to recite a substantially square shape for the cavity. Support for this amendment is found at page 6, second paragraph. Accordingly, no new matter is added.

### Rejection under 102(b)

The rejection of claims 1, 3-5, 7, 8 and 10 as anticipated by U.S. Patent No. 4,846,477 to Phelan is respectfully traversed. “To anticipate a claim, the reference must teach every element of the claim.” MPEP § 2131. In this case, Phelan fails to meet this requirement.

As amended, claims 1, 3-5, 7, 8 and 10 call for a golf club head comprising a body, an aligning portion having an indicative means, and a striking portion having a cavity. The cavity of the striking portion is encompassed by at least three faces comprising a first striking face, a second striking face, and a third striking face, such that the golf ball hit by the first striking face is capable of moving along the intended movement path toward the target hole, while the golf ball hit by the second or third striking face fails to move along the intended movement path. The cavity of the striking portion is shaped substantially as a square.

Phelan teaches a golf putter 10 having a groove 54. As shown in Figs. 1, 3, 4 and 5, the groove 54 has a left contact surface 56, a right contact surface 58, and a middle non-contact surface 60, wherein the left contact surface 56 intersects a plane through y-axis 30 and z-axis 32 at an angle 66 of about 30 degrees, and the right contact surface 58 also intersects a plane through y-axis 30 and z-axis 32 at an angle 68 of about 30 degrees (column 2, lines 35-37 and lines 42-46). Thus, in contrast to claims 1, 3-5, 7, 8 and 10, Phelan does not teach or suggest a substantially square-shaped cavity of the striking portion.

Further, as described in column 2, lines 37-41 (Fig. 3) of Phelan, when ball 12 is in contact with both left and right contact surfaces 56, 58, there is a clearance 64 between the middle non-contact surface 60 and the adjacent surface of the ball 12. As described in column 2, line 47 to column 3, line 2 for Figs. 4 and 5, no matter whether the ball 12 contacts the left contact surface 56 (position 70 in Fig. 4) or the right contact surface 58 (position 76 in Fig. 5), the groove 54 will allow the ball 12 to contact both contact surfaces 56, 58 and move along axis 30 to pass through position 74 in its forward movement.

The groove 54 of Phelan works in a different way than the cavity of the striking portion in the present invention. Unlike the groove of Phelan, the present invention does not require the ball to contact both left and right contact surfaces to move forward. Also, in contrast to the putter of Phelan, there is neither a “non-contact surface” nor a “clearance” for the cavity in the present invention.

Because the Phelan reference fails to teach or suggest a substantially square shaped cavity or a middle contacting surface, the reference fails to teach every element of claims 1, 3-5, 7, 8 and 10. Accordingly, the claims are not anticipated.

**Rejection under 103(a)**

The rejection of claims 1-8 and 10 as obvious over U.S. Patent No. 5,476,262 to Bandiero in view of U.S. Patent Nos. 4,962,931 to Jazdzyk, 5,690,556 to Condon, and 3,954,265 to Taylor is respectfully traversed. “To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.” *In re Royka*, 490 F. 2d 981, 180 USPQ 580 (CCPA 1974); MPEP § 2143.03. In the present case, the prior art does not meet this standard.

The Office Action considers that Bandiero has taught the features of the golf club head of the present invention except for “indicative means.” The Office Action alleges that Jazdzyk, Taylor and Condon teach the indicative means and can be combined with Bandiero to render claims 1-8 and 10 obvious. However, the claims are not obvious because Bandiero does not teach or suggest the cavity of the striking portion called for in the claims.

Bandiero teaches a putter trainer having a ball space 39 that is defined between side walls 20, 22 and rear wall 26. As described in column 5, lines 29-34 (FIGS. 1 and 2), the rectangular shape of space 39 creates an elongated target line between ball 44, the surface 46 of the golf club and the target, so as to help to align putting, shorten backswing and lengthen follow-through. Moreover, as described in column 8, lines 48-65 of Bandiero, the object to be achieved by the putter trainer is to force the user to make a perfectly straight follow-through. The material of the putter trainer will produce an audible sound to tell the user of the ball striking situation, that is, a “click-click” sound means an undesired follow-through or a “double-hit” (i.e. the ball strikes the side wall before striking the rear wall), and a single “click” sound means a desired follow-through.

The arrangement of the ball space 39 taught in the Bandiero reference contrasts with the cavity of the striking portion in the present invention. Unlike the Bandiero reference, the substantially square-shaped cavity in the present invention does not provide an elongated target line or readily produce a double-hit. Because Bandiero does not teach or suggest a substantially square-shaped cavity, Bandiero fails to teach or suggest all claim limitations. Accordingly, claims 1-8 and 10 are not obvious.

The Commissioner is hereby authorized to charge payment of any fees required associated with this communication or credit any overpayment to Deposit Account No. 50-0337. If an extension of time is required, please consider this a petition therefor and charge any additional fees which may be required to Deposit Account No. 50-0337. A duplicate copy of this paper is enclosed.

In view of the forgoing amendment and remarks, Applicant submits that the present application is in condition for allowance. A Notice of Allowance is therefore respectfully requested.

Dated: August 2, 2005

Respectfully submitted,

  
Miles Yamanaka  
Reg. No. 45,665

FULBRIGHT & JAWORSKI L.L.P  
555 South Flower Street , 41<sup>st</sup> Floor  
Los Angeles, CA 90071  
(213) 892-9200 – Telephone  
(213) 892-9494 - Facsimile